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EXAMINER

JOLLEY, KIRSTEN

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/900,746
Filing Date: July 06, 2001
Appellant(s): GINGRAS ET AL.

Amanda M. Church
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 9, 2005 appealing from the Office action mailed December 28, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

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The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US-4601938	Deacon et al.
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US-5667635	Win et al.
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WO-01/40090 A2	Perini
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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-7, 9-12, 14, 16-19, and 21-48¹ are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/40090 A2 (hereinafter “Perini”).

Perini discloses a method of making wet rolls, comprising the steps of: providing a web of material, applying a wetting solution to the web to produce a wet web, and winding the wet web into rolls using a roll-forming pocket using the apparatus illustrated in Figure 1. Perini teaches on page 7 that a liquid-based product which impregnates or moistens the material before forming the roll L is applied to web material N after the web material N is delivered from a perforating unit.

The Examiner acknowledges that Perini teaches that the web material should be “substantially dry” at the changeover zone. Perini states that it is not preferred to break the web

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in the method of Perini when the web is wet because the presence of moisture or liquid impregnating the material would make the changeover difficult. However, it is the Examiner's position that it would have none-the-less been obvious to one having ordinary skill in the art to have performed breaking of the web while it was wet with the expectation of achieving worse, but still successful, results. The negative teaching in Perini is still a fair teaching that, although more difficult, one skilled in the art would have had an expectation of success. There is nothing in Appellant's claims to show that Appellant's process is any different or achieves better results than the prior art teaching of Perini.

As to the speed limitation, Perini lacks a teaching of the speed at which its web travels. It is the Examiner's position that the travel speed of the web is a cause-effective variable. One skilled in the art would have been motivated to maximize the travel speed in order to increase productivity and efficiency of the process, however the travel speed must not be too fast that it causes the wet web to undesirably break or stretch during rolling. It is well settled that determination of optimum values of cause effective variables such as these process parameters is within the skill of one practicing in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980).

With respect to independent claim 18, the web of material in the process of Perini is inherently provided from a source and Perini teaches perforating the web at page 7, line 4. The draw of the web is controlled via roller 1. The web is positioned adjacent wetting apparatus 7, as shown in Figure 1, and wetting solution is applied to at least one side of the web to yield a wet web. The amount of wetting solution would be determined by one skilled in the art as discussed below.

¹ Appellants correctly noted in the footnote on page 2 of the Appeal Brief that paragraph 7 of the Final Rejection

With respect to claims 31-33 and 39, Perini teaches a roll forming pocket/winding cradle comprised of three rollers 1, 3, 5 (illustrated in Figure 1) to form the rolls L or "cigarettes." In the roll forming pocket of Perini, rollers 1, 3, and 5 each contact the wet web and each rotate in the same circular direction, whereby the second roller 3 rotates in a circular direction opposite from the direction of the movement of the wet web. Perini teaches that after forming roll L, the web wet roll L is separated from the web and discharged from the roll forming pocket (see page 7, lines 3-13).

As to claims 2-7, 24-28, 38, and 41-46, Perini lacks a teaching of the add-on amount of wetting solution applied on the web in its invention. It is the Examiner's position that one having ordinary skill in the art would have been motivated to determine the optimum amount of wetting solution to be added to the substrate depending upon the desired feel and wetness of the final product and the amount that may be applied without causing the wet web to be so weak that it does not break during winding.

With respect to the speed of claims 9-11, 22, and 37, it is the Examiner's position that the speed would be optimized through routine experimentation as discussed above with respect to claim 1.

As to claims 12 and 30, Perini teaches that preferably the roll L is coreless (page 5, lines 12-14).

As to claim 14, Perini teaches that the may be non-woven fabric in page 3, line 13.

As to claim 17, Perini teaches uniformly distributing the wetting solution in the web in col. 8, lines 15-16.

As to claims 16, 29, 36, and 48, Perini lacks a teaching that the method of its invention is performed in an environment that is substantially free of contamination. However, the Examiner notes that Perini is concerned with making hygienic products comprising disinfectants or detergents as taught on page 1. It would have been obvious for one having ordinary skill in the art to have performed the process of Perini in a contaminant-free environment in order to ensure that the products remain sterile and free of germs and/or bacteria that would negate their utility.

With respect to claim 19, Perini does not teach that the web material is originally supplied on a roll and unwound. It is the Examiner's position that it would have been obvious to have supplied the web material via a wound roll because such is well known in the art in order to maintain the web material which is fed to a rolling apparatus in an orderly manner.

With respect to claims 23 and 47, Perini teaches that the wetting solution may comprise detergents. It is well known in the art that detergent compositions comprise salts.

As to claim 35, Perini does not teach that the break of step b) occurs along a line of perforation. It is the Examiner's position that it would have been obvious for one having ordinary skill in the art to have made the break in Perini's rolling process along a perforation because the web is more easily torn in that region, and therefore is less likely to cause an uneven edge in the web.

Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/40090 A2 (hereinafter "Perini") as applied to claims 1-7, 9-12, 14, 16-19, and 21-48 above, and further in view of Deacon et al. (US 4,601,938).

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Perini is applied for the reasons discussed above. Perini lacks a teaching of the specifics of the web used to form its wet web, and specifically using a web comprising a wet-formed basesheet or water-dispersible binder. Deacon et al. is cited as being directed to a web material which may be wetted with a cleaning composition and then rolled to form wet wipes. See col. 7, lines 42-59 of Deacon et al. Deacon et al. teaches that the web substrate may be non-woven fabric, and preferably wet laid nonwoven fabric, in col. 3, lines 34-38. Alternatively, Deacon et al. teaches that the fabric may comprise acrylic resin binder which is water-dispersible (col. 3, lines 57-58). It would have been obvious for one having ordinary skill in the art to have used the web substrate taught by Deacon et al. as the web material in the process of Perini with the expectation of successful results since Perini is not limited to the web material that may be used in its process and because Deacon et al. teaches exemplary material that may be used in a similar wet web-forming process.

Claims 1-7, 9-19, and 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deacon et al. (US 4,601,938).

Deacon et al. teaches in col. 7, lines 42-59, a method of impregnating a dry web substrate with a liquid wax and then a liquid cleaning composition, then passing the wet web through a perforator and a slitter, and winding the wet web in the form of a coreless roll. Perforating and slitting the wet web meet the limitation of breaking the wet web.

As to the speed limitation, Deacon et al. lacks a teaching of the speed at which the web travels. It is the Examiner's position that the travel speed of the web is a cause-effective variable. One skilled in the art would have been motivated to maximize the travel speed in order

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to increase productivity and efficiency of the process, however the travel speed must not be too fast that it causes the wet web to undesirably break or stretch during rolling. It is well settled that determination of optimum values of cause effective variables such as these process parameters is within the skill of one practicing in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980).

With respect to claim 18, the web of material in the process of Deacon et al. is unwound from supply roll 11. The draw of the web is controlled via roller 11. The web is positioned adjacent wetting apparatus 22, as shown in Figure 7, and wetting solution is applied to one side of the web to yield a wet web. The amount of wetting solution would be determined by one skilled in the art as discussed below.

As to claims 2-7 and 24-28, Deacon et al. lacks a teaching of the add-on amount of wetting solution applied on the web in its invention. It is the Examiner's position that one having ordinary skill in the art would have been motivated to determine the optimum amount of wetting solution to be added to the substrate depending upon the desired feel and wetness of the final product and the amount that may be applied without causing the wet web to be so weak that it does not break during winding.

With respect to the speed of claims 9-11, and 22, the claims are rejected for the same reasons discussed above with respect to claim 1.

As to claims 13-15, Deacon et al. teaches that the web may be non-woven fabric, and preferably wet laid nonwoven fabric, in col. 3, lines 34-38. Alternatively, Deacon et al. teaches that the fabric may comprise acrylic resin binder which is water-dispersible (col. 3, lines 57-58).

As to claim 17, Deacon et al. illustrates uniformly distributing the wetting solution in Figure 7.

As to claims 16 and 29, Deacon et al. lacks a teaching that the method of its invention is performed in an environment that is substantially free of contamination. However, the Examiner notes that Deacon et al. is concerned with making personal cleaning products. It would have been obvious for one having ordinary skill in the art to have performed the process of Deacon et al. in a contaminant-free environment in order to ensure that the products remain sterile and free of germs and/or bacteria that would negate their utility.

With respect to claim 23, Deacon et al. teaches that the liquid composition may comprise detergent-active agents (col. 4, lines 18-21). It is well known in the art that detergent compositions comprise salts.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/40090 A2 (hereinafter "Perini") or Deacon et al. as applied to claim 18 above, and further in view of Win et al. (US 5,667,635).

Perini and Deacon et al. lack a teaching of combining at least two web plies into a single web for use as the web substrate. Win et al. is cited as disclosing a web substrate for a pre-moistened wet wipe that comprises multiple plies for strength. Win et al. states that "multiple plies or sheets are brought together because multiple, low basis weight sheets will dispose more readily than a single, heavy basis sheet" (col. 1, lines 38-40). It would have been obvious for one having ordinary skill in the art to have combined multiple plies of base sheets together to form the web substrate material for use in the processes of Perini or Deacon et al., upon seeing the reference of Win et al., in order to form a stronger product that will more readily disperse in water.

(10) Response to Argument

With respect to the rejection of claims 1-7, 9-12, 14, 16-19, and 21-48 under 35 USC 103(a) over WO 01/40090 A2 (Perini), Appellants argue that Perini includes the step of breaking the web of material when the material is dry, and Perini actually teaches away from breaking the web when the web is wet. Appellants argue that Perini says “the presence of moisture or liquid impregnating the material would make the changeover difficult or would in some cases even render it impossible” and that there can be no suggestion or motivation to modify the Perini method to include the breaking of a wet web in view of the teachings in the reference.

Appellants further cite *In re Mills* which states that “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination.” First, it is noted that the rejection over the Perini reference is not made over a combination of references. The teaching of breaking a wet web in Perini, while a negative teaching and one that is expected to make the process more difficult, is still a fair teaching and would have been a known modification to one skilled in the art reading the reference with an expectation of success. There is nothing in Appellants’ arguments or claims to show that Appellants’ process is any different or achieves better results than the prior art teaching of Perini. Appellants further state that Perini’s teaching that it would be difficult, if not impossible, to effectuate a successful changeover if the web is wet when it is broken is an indication to one skilled in the art that the presence of moisture before the changeover would produce unsatisfactory results. The Examiner disagrees. Perini states that the presence of

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moisture or liquid would make the changeover “difficult”; this is not necessarily a statement that results would be unsatisfactory.

With respect to the rejection of claims 1-7, 9-19, and 21-30 under 35 USC 103(a) over Deacon et al., Appellants argue that the Examiner fails to address the fact that Deacon et al. does not teach or suggest to one skilled in the art how the speed might be maximized, and the Examiner is using an improper “obvious to try” rationale. The Examiner disagrees. As stated in the prior Office actions, while Deacon et al. lacks a teaching of the speed at which the web travels, it is the Examiner’s position that the travel speed of the web is a cause-effective variable. One skilled in the art would have been motivated to maximize the speed at which the web travels in order to increase productivity and efficiency of the process, however the travel speed must not be too fast that it causes the wet web to undesirably break or stretch during rolling. One skilled in the art would have recognized that the speed would be dependent upon a number of factors, including the thickness, strength, specific material and weight of the web, the type and amount of wetting solution supplied, the specific equipment used, etc. It is well settled that determination of optimum values of cause effective variables such as these process parameters is within the skill of one practicing in the art. *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Appellants further argue that the specification (at page 24, lines 14-30) defines the term “breaking” as the action creating a leading edge connected to the trapped portion of the web by pulling the web back or stalling the web on the smooth insert separating, or breaking, the perforation. The Examiner disagrees. The cited passage merely describes that an action of pulling the web back “breaks” the web. This is not a clear and limiting definition of the term

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“breaking” as provided in the claims, nor is such a definition provided elsewhere in the specification. It remains the Examiner’s position that the term “breaking” is a broad limitation that reads on any step of separating into parts, and therefore the step of slitting performed in Deacon et al.’s process meets the limitation of breaking the wet web.

Appellants argue that one of skill in the art would interpret “slitting” a web of paper to mean a separation of the web of material in the machine direction (MD), whereas “breaking of the wet web” indicates a separation of the web of material in the cross-machine direction (CD) to form a leading edge connected to the trapped portion of the web. Appellants state that it is inappropriate to assign a new meaning to a term commonly used in the industry. The Examiner disagrees that the term “breaking” is only used in industry to mean a separation in the cross-machine direction, and further notes that there was no evidence supplied to support this position.

Additionally, it is noted that, while not specifically stated by Deacon et al., it is a well known and normal operation in a manufacturing process to produce multiple smaller rolls from a single larger master roll of the untreated web. A step of breaking the web of Deacon et al. at any point in time during manufacturing to form a second small roll (suitable in size for commercial sale) would read on Appellants’ claim 1 which merely requires “breaking the wet web.”

With respect to the rejections of claims 13 and 15 under 35 USC 103(a) over Perini in view of Deacon et al., Appellants argue that the Examiner has not provided Appellants with any motivation, either in the references or in the state of the art that would suggest the combination of Perini and Deacon. The Examiner disagrees. Perini lacks a teaching of the specifics of the web material used to form its wet web. Perini and Deacon et al. are similarly directed to a web

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material which may be wetted with a cleaning composition and then rolled to form wet wipes.

See col. 7, lines 42-59 of Deacon et al. Deacon et al. teaches that a web substrate used to make rolls of wet webs may be non-woven fabric, and preferably wet laid nonwoven fabric.

Alternatively, Deacon et al. teaches that the fabric may comprise acrylic resin binder which is water-dispersible (col. 3, lines 57-58). It would have been obvious for one having ordinary skill in the art to have used the web substrate taught by Deacon et al. as the web material in the process of Perini with the expectation of successful results since the two references are similarly related in the field of producing rolls of wet webs, and because Perini is not limited to the web material that may be used in its process and Deacon et al. teaches exemplary material that may be used in a similar wet web-forming process.

With respect to the rejection of claim 20 under 35 USC 103(a) over Perini or Deacon et al., in view of Win, Appellants argue that neither Perini or Deacon suggests altering the references to provide "breaking a wet web." The Examiner disagrees for the reasons discussed above.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Kirsten C. Jolley
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KIRSTEN JOLLEY
PRIMARY EXAMINER

Conferees:

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Glenn Caldarola

A handwritten signature in black ink, appearing to read 'Glenn Caldarola', with a stylized, flowing script.

Glenn Caldarola
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